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Attachment to Advisory Action

The applicants have amended claim 1 to narrow the range of the tensile modulus of elasticity to 240 to 1500 MPa; the density of the LDPE to 0.923 to 0.933 g/cm³; the density of the HDPE to 0.950 to 0.959 g/cm³; and the ratio of the LDPE to HDPE to 50 to 90 pbm relative to 100 pbm of the LDPE/HDPE mixture. The applicants have also amended claim 1 to replace "comprising a mixture" to "composed of a mixture." The applicants have also amended the claims to include new claim 8 further limiting the LDPE resin to a straight chain LDPE, and the specification to describe the surface to which the film of the present invention was adhered as "having a three-dimensional curved surface" (see page of amendments). The amendments have been fully considered but are not entered for the reasons set forth below.

The amendments to the claims have not been entered given that the current amendments have altered the scope of the current invention by further limiting the ranges therein, and thus require further consideration. Further, the amendments are not being entered given that the amendments to the specification raise new issues that would require further consideration under 35 U.S.C. 132(a) given that the amendment introduces new matter into the specification.

It is noted that even if the amendments to the claims were entered, claims 1, 3 and 5-8 would not be allowable over the prior art of record given that the Ukei reference still anticipates the amended portions of current claim 1 as set forth in the previous action, and paragraph 0038, line 6 of the reference teaches the straight chain low density polyethylene resin as recited in new claim 8.

With respect to the amendments to the specification, the applicants assert that one of ordinary skill in the art would know that the surface of an aluminum wheel of the [CERICO] vehicle has a 3-D curved surface shape. The examiner argues that the amended portions of the specification constitute new matter regardless of whether one of ordinary skill would be apprised that said wheel has a curved surface (emphasis provided by the examiner) since the specification as originally filed does not explicate whether the PSA film(s) of the present were necessarily applied to a curved surface or some other non-curved surface of the [CERICO] wheel. In addition, the applicants' have provided no evidence (i.e. picture or diagram) to support their assertion that said wheel indeed has curved surface(s). It is noted that the amendments contain the trademarked wheel as "Cercio," while the applicants' argument refer to the wheel as "Cerico." Clarification is requested.

With respect to the rejection of claims 1, 5 and 7 over Ukei et al. (US 2005/0058829) under 35 U.S.C. 102(a), the applicants argue, see pages 6-8, filed 4/8/2010, that Ukei does not anticipate claim 1 given that Ukei does not teach the claimed elasticity of the plastic film nor the use of the of a polyethylene resin film composed of a mixture of a LDPE resin having a density of 0.923 to 0.933 g/cm³ and a HDPE resin having a density of 0.950 to 0.959 g/cm³, wherein a ratio of the LDPE is 50 to 90 parts by mass to 100 parts by mass of the HDPE/LDPE mixture .

As set forth in the previous action and restated here it is noted that, given that the Ukei reference discloses a supporting substrate made of a plastic film of a material and having a thickness identical to that presently claimed, including the same proportion (i.e., ratio of LDPE to the HDPE/LDPE mixture) of HDPE and LDPE, it is clear, absent evidence to the contrary, that the supporting substrate made of a plastic film would inherently possess the tensile modulus of elasticity of the surface substrate film of the present invention.

Also, the recitation in the claims that the surface substrate film having a PSA layer on at least surface is "for adhering onto a motor vehicle wheel" as a "motor vehicle brake disc antirust film" is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Ukei et al. reference discloses supporting substrate made of a plastic film and a PSA layer formed on at least one side of the substrate as presently claimed, it is clear that the invention of Ukei et al. would be capable of performing the intended use, i.e. a motor vehicle brake disc antirust film for adhering onto a motor vehicle wheel, presently claimed as required in the above cited portion of the MPEP.

The applicants provide reference to the examples and comparative examples of the Ukei reference as further evidence that the Ukei reference does not anticipate the presently claimed mixture of HDPE and LDPE, the presently claimed densities, and the presently claimed ratios, nor would the claimed mixture be obvious given that the currently claimed ranges disclosed in paragraph 0039 of Ukei are inconsistent with the ranges of the comparative examples as the said comparative ranges provided poor characteristics/properties as set forth in Table 4 of the reference. The applicants also assert that the Ukei reference does not disclose, teach or suggest the effects of the claimed invention. Finally, for at least the same reasons as the applicants allege that claim is patentable, the applicants further assert that dependent claims 3 and 6 are patentable over Ukei in view of Endo or Watanabe.

The examiner respectfully disagrees with the applicants' dismissal of the full disclosure of the Ukei given that, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Also, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." (In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967)). Finally, while the comparative examples of Ukei may be inconsistent with the HDPE and LDPE ranges disclosed in paragraph 39 of the reference, the fact remains that paragraph 39 of Ukei discloses that the most preferable ranges of density overlap those presently claimed.

In addition, while Ukei does not specifically disclose, teach or suggest the effects of the claimed invention, it is further noted that case law provides that “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. The court stated that “just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel.” Id. (See also MPEP § 2112.01 and MPEP § 2141.02).

Also, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency);

see also Toro Co. v. Deere & Co., 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) (“[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.”); Abbott Labs v. Geneva Pharmas., Inc., 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed.Cir.1999) (“If a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics.”); Atlas Powder Co. v. Ireco, Inc., 190 F.3d 1342, 1348-49 (Fed. Cir. 1999) (“Because sufficient aeration’ was inherent in the prior art, it is irrelevant that the prior art did not recognize the key aspect of [the] invention.... An inherent structure, composition, or function is not necessarily known.”); SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331, 1343-44, 74 USPQ2d 1398, 1406-07 (Fed. Cir. 2005) (holding that a prior art patent to an anhydrous form of a compound “inherently” anticipated the claimed hemihydrate form of the compound because practicing the process in the prior art to manufacture the anhydrous compound “inherently results in at least trace amounts of” the claimed hemihydrate even if the prior art did not discuss or recognize the hemihydrate).

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